



**UNITED STATES DEPARTMENT OF COMMERCE**

**Unit d States Pat nt and Trademark Offic**

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Washington, D.C. 20231

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/414,121 10/08/99 STEEL

S 9921/50

022917  
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TM02/0524

EXAMINER

ALVAREZ, R

ART UNIT

PAPER NUMBER

2162

DATE MAILED:

05/24/01

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

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**Office Action Summary**

Application No.

09/414,121

Applicant(s)

STEEL ET AL.

Examiner

Raquel Alvarez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

**Attachment(s)**

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 18) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

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### **DETAILED ACTION**

1. This action is in response to communication filed on 2/20/2001.
2. Claims 1-20 are presented for examination.

### **Specification**

Brief Summary of the Invention is missing: A brief summary or general statement of the invention as set forth in 37 CFR 1.73. The summary is separate and distinct from the abstract and is directed toward the invention rather than the disclosure as a whole. The summary may point out the advantages of the invention or how it solves problems previously existent in the prior art (and preferably indicated in the Background of the Invention). In chemical cases it should point out in general terms the utility of the invention. If possible, the nature and gist of the invention or the inventive concept should be set forth. Objects of the invention should be treated briefly and only to the extent that they contribute to an understanding of the invention.

### **Claim Rejections - 35 U.S.C. § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Altschul et al.(5,983,094 hereinafter Altschul) in view of Goldhaber et al.(5,855,008 hereinafter Goldhaber) further in view of Hall et al.(6,026,375 hereinafter Hall).

In regard to claims 1, 9 and 12, Altschul teaches providing services in a wireless communication network(Abstract).

Providing a plurality of service to an end user of a wireless communication device operating on said wireless communication network (i.e. the wireless telephone(10) is constructed to enabled the customer to subscribe to a variety of services); providing products or services to said end user in response to a subscription to one of the services(i.e. the end user accepts some of the current products and/or services provided by the sponsor by entering a credit card number)(col. 4, lines 59-, col. 5, and lines 1-34).

Altschul does not specifically teach providing advertisements to the end user in lieu of receiving compensation for the subscription. Goldhaber teaches that the customers receive direct payment for receiving advertisements, which can be used to pay for goods and services(col. 12, lines 5-14). It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included the teachings of Goldhaber of providing advertisements to the end user in lieu of paying for the subscription because such a modification would allow the advertisers to perhaps influence the customers minds in buying additional products or services by means of the advertisements(col. 6, lines 20-27).

The combination of Altschul and Goldhaber do not specifically teach that the advertisements are based on the location related information of the wireless device.

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Hall teaches that the mobile location determination system (145) determines the location of the user in order to determine the local facilities or vendors that can provide an offer(advertisement) based on the customer's preference and their location (col. 7, lines 19-28; col. 8, lines 31-42). It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included advertisements based on the location related information of the wireless device because such a modification would allow the customers or users to receive local advertisements of local facility capable of completing the order based on the customer's location (in Hall, col. 2, lines 29-31).

With respect to claim 2, Altschul teaches that the user of the wireless communication network can subscribe to any of the plurality of service options. Altschul does not specifically teach that the service options include location based services. On the other hand, Hall teaches that the services options available are based on the location of the end user(Figures 2 and 3). It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included location based services because such a modification would enable the system to determine a local facility that can satisfy the customer's order(In Hall, Abstract).\*

With respect to claim 3, Hall teaches that the location related information Includes position and speed (col. 5, lines 30-43 and col. 7, lines 19-28). It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included position in the location related information because such a modification

would enable the system to better service the customer based on their location position.

With respect to claim 4, Hall further teaches that the step of providing advertisements comprises providing an advertisement for a predetermined vendor when a subscriber is within a predetermined distance of said predetermined vendor(i.e. the facilities database(372) contains a list of participating local facilities(vendors that are within a predetermined distance ) that can provide or fill an order for a customer). It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included providing an advertisement for a predetermined vendor when a subscriber is within a predetermined distance of the predetermined vendor because such a modification would allow the customer to be aware of the vendors that are close by.

With respect to claim 5, Hall further teaches providing advertisements when the end user preference corresponds with vendor criteria(i.e. based on the customer's identifying criteria and what the service provider offers(vendor) an individualized package and special tailored to meet the individual needs are presented to the customer)(Figure 6B). It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included advertisements when end user preferences corresponds with vendor criteria because such a modification would allow the system to better target the advertisements.

With respect to claim 6, Goldhaber teaches requiring user interaction to determine whether an advertisement was reviewed to be considered an advertisement that was provided in lieu of receiving compensation for the service (i.e. the user has to provide a

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response to the ad to enable the advertiser to be assure that the customer reviewed the ad)(col. 5, lines 61-, col. 6, lines 1-7). It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included requiring user interaction to determine whether an advertisement was reviewed to be considered an advertisement that was provided in lieu of receiving compensation for the service because such a modification would assure the advertiser that the customer is entitled to the compensation.

With respect to claims 7 and 8, Hall teaches that the advertisements are based upon a shopping list of said end user and shopping history of the end user (i.e. based on the customer's prior purchasing behavior and based on what they currently want to purchase, a list of local facility and what they offer is provided to the end user(Figure 3).

It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included advertisements that are based upon a shopping list of said end user and shopping history of the end user because such a modification would allow the system to better target the advertisements.

Claim 10 further recites providing advertisements based upon the content that a user is receiving on said wireless communication device. Since, Altschul teaches a wireless communication device in which a customer can receive telephonic communications and can sign up to various services(col. 3, lines 51-56).Altschul does not specifically teach providing advertisements based on the content that the user is receiving. Goldhaber teaches that based on the content of the items that the customer is receiving, a coupon or advertisement is provided(Figure 11) then it would have been

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obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included providing advertisements based on the content that the customer is receiving because such a modification would allow the advertisements to be targeted to the customer's needs, interests and preferences(in Goldhaber, col. 5, lines 31-34).

Claim 11 recites providing advertisements at predetermined times based upon user device habits. Since, the combination of Altschul and Hall teach that the system agent(360) accesses customer database(374) and retrieves information about customer's preferences to enable the system to provide advertisements based on the customer's preferences(in Hall, Figure 6B) then it would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included as a predetermined time to provide the advertisements based on the user's habits because such a modification would provide the advertisements at a time that would be convenient to the user.

With respect to claim 13, the limitations were previously addressed in the rejections to claims 1 and 4 and therefore is rejected under similar rationale.

Claim 14 is similar in scope as claim 6 and therefore is rejected under similar Rationale.

Claims 15 and 16 are similar in scope as claims 7 and 8 and therefore are rejected under similar rationale.

Claim 17 is similar in scope as claim 9 and therefore is rejected under similar rationale.

Claim 18 is similar in scope as claim 10 and therefore is rejected under similar



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rationale.

Claim 19 is similar in scope as claim 11 and therefore is rejected under similar rationale.

With respect to claim 20, the limitations were previously addressed in the rejections to claims 1 and 5 and therefore is rejected under similar rationale.

### **Conclusion**

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raquel Alvarez whose telephone number is (703)305-0456. The examiner can normally be reached on 9:00-5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric w Stamber can be reached on (703)305-8469. The fax phone numbers for the organization where this application or proceeding is assigned are (703)305-0040 for regular communications and (703)305-0040 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-3900.

*R.A.*  
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May 19, 2001



ERIC W. STAMBER  
PRIMARY EXAMINER